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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,779

07/28/2006

Gordon Thelwell

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EXAMINER

RODDEN, JOSHUA E

ART UNIT

PAPER NUMBER

3637

MAIL DATE

DELIVERY MODE

12/08/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,779	<b>Applicant(s)</b> THELWELL, GORDON	
	<b>Examiner</b> Joshua Rodden	<b>Art Unit</b> 3637	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-71, 74-83, 86 and 87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-71, 74-83, 86 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 and 05 November 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-60, 72, 73, 84, 85 and 88 have been cancelled. Claims 61, 65, 74, 78 and 79 have been amended.

### ***Drawings***

1. The Replacement Drawings were received on 11/05/10. These drawings are acceptable.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the “wall portions 503 (See Page 15, Paragraph 3 of the specification)” and the “Off center Impact forces 1100 (See Page 22, Paragraph 2 of the specification).” Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 65 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 61 recites "a rigid substantially cylindrical outer shell" and claim 65 recites "said outer shell comprises a tubular part cylindrical member." Is the "outer member" supposed to be "cylindrical" or "part cylindrical"?

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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**7. Claim 61-69, 71, 74-83, 86 and 87 rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 6,684,572 (Homolka et al.).**

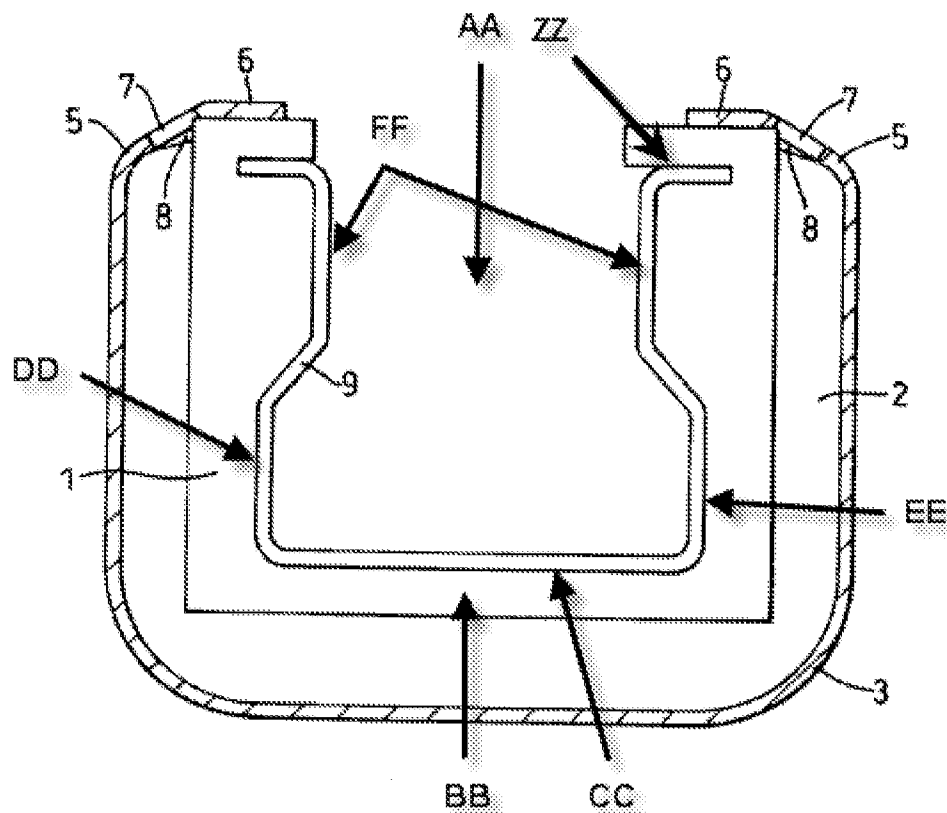
Regarding **Claims 61-64, 80-83, 86 and 87**, Ian teaches; **Claim 61** - a column protecting device (3) for protection of an upright column (9) of a racking system, (Figure 3); wherein the column (9) has a channel shaped cross section (AA) having a substantially rectangular front portion (BB) consisting of a front member (CC), and a first (DD) and second (EE) side member, (Annotated Figure 2 Below); the column protector device (3) being arranged to clip onto the upright column (9), (Figure 2 and Page 4, Lines 10-14); the protector device further comprises a rigid part cylindrical "C" shaped cross section outer shell (3), and an inner liner (1 and 2) shaped to fit within the outer shell (3), (Figure 2 and Page 3, Lines 3-8 of the specification); wherein the outer shell (3) is capable of fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-14); the outer shell (3) also surrounds the front member (CC) and partially surrounds (does not surround the tips labeled as ZZ) the first (DD) and second (EE) side members, (Annotated Figure 2 Below); the inner liner (1 and 2) being retained between the outer shell (3) and the column (9), (Figure 3); the inner liner (1 and 2) comprises a solid substantially part cylindrical member having a substantially part cylindrical outer surface (the outer corners of (2) are rounded and the inner liner is therefore part cylindrical), the inner liner (1 and 2) also having a substantially "U" shaped channel (the inner surface of the liner (1) touching the upright column (9)) formed on an opposite side of said inner

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liner to said substantially part cylindrical outer surface and in which, in use, said channel provides for a flush interface between the inner liner (1 and 2) and the upright column (9), (as seen in Figure 2); **Claim 62** – wherein each of the first and second side members (DD and EE) comprises an outer (DD and EE) and an inner side member (FF), (Annotated Figure 2 Below); the outer shell (3) when fitted to the column (9) surrounds the front member (CC) and said first and second side members (DD and EE), thereby protecting them, (Annotated Figure 2); the outer shell (3) partially surrounds the first and second inner side members (FF) so that the exposed upright edges (the end edges near item (6) in Annotated Figure 2) of the outer shell (3) lay adjacent to the sides of the column at a position where the column is relatively narrower, (Annotated Figure 2 Below); **Claim 63** – wherein, in use, the column (9) resides partially within a channel formed by the outer shell (3), (Figure 2); **Claim 64** – wherein said outer shell (3) comprises an elongate member having a substantially “C” shaped cross section, (Figure 2); **Claim 80** – wherein said inner liner (1 and 2) is capable of, after receiving an impact, the inner liner (1 and 2) promotes the repositioning of the whole device to an original shape before the impact occurred, (Figure 2 and Page 4, Lines 3-8); **Claim 81** - the outer shell (3) surrounding the front member (CC) and partially surrounding (does not surround the tips labeled as ZZ ) the first (DD) and second (EE) side members, and also surrounding the inner liner (1 and 2), which rests between a substantially part cylindrical inner surface of the outer shell (3) and an outer face of the front member (CC), an outer face of the first side member (DD) and second side members (EE), (Annotated Figure 2 Below); **Claim 82** - the inner liner and outer shell being slideable with respect to each

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other along a central axis of the outer shell, (Page 1, Lines 24-28); **Claim 83** - the outer liner and an inner liner being bonded together, (Page 2, Lines 1-5); **Claim 86** - the outer shell and the inner liner composed of polycarbonate and foam (Page 2, Line 8 and Page 2, Lines 6-7); both materials having greater ductility, and impact resilience than the shelving which is made from metal (Page 1, Lines 12-14); **Claim 87** - teaches the device being "capable of" fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-15).



Annotated Figure 2

**Ian** does not teach: wherein the outer shell is substantially cylindrical with a substantially "C" shaped cross section (**Claim 61**). However, **Homolka et al.** teaches:

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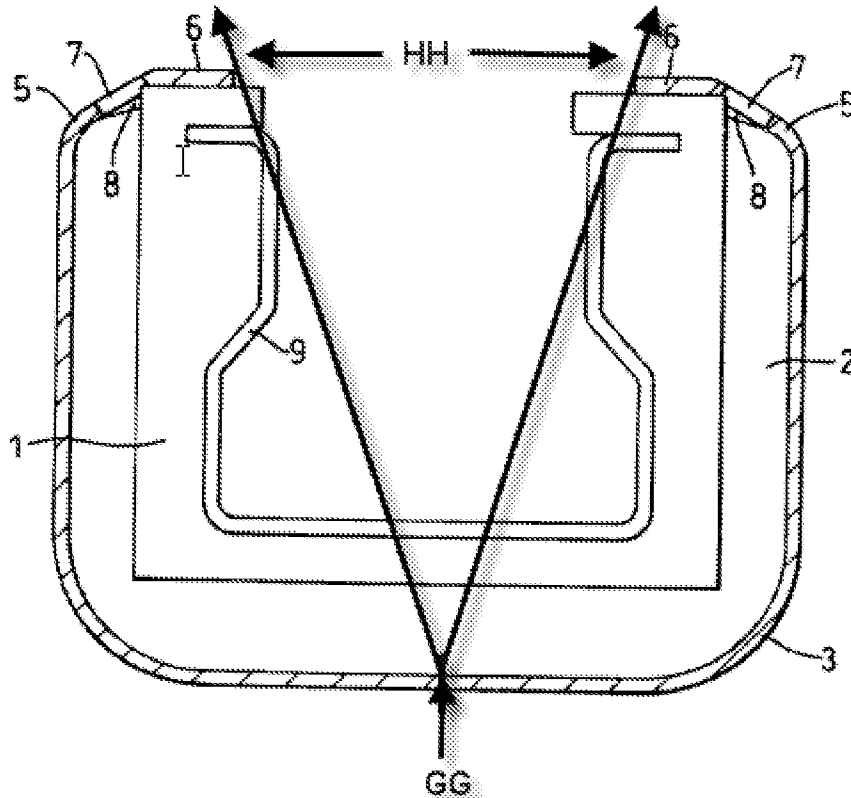
**Claim 61** – an outer shell (8) which is substantially cylindrical with a substantially “C” shaped cross section, (Figures 1-5). Therefore, it would have been obvious to one of ordinary skill in the art to modify the outer shell of the column protector of **lan** to have wherein the outer shell is substantially cylindrical with a substantially “C” shaped cross section (**Claim 61**) as taught by **Homolka et al.** for the purposes of having a shape which has no sharp corners which allows for a safer device which also is more efficient at deflecting impact forces. Additionally, it should be understood that it is extremely well known in the art to make bumpers and Column guards cylindrical in cross section as is evidenced by: U.S. Patents No. 1,620,933 (Wilcox), No. 3,372,552 (Liddel), No. 4,113,110 (Mittag), No. 5,482,238 (Kreiter), No. 6,102,611 (Roller) and No. 6,242,070 (Gillispie et al.).

Regarding **Claim 65**, **lan as modified by Homolka et al.** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to **lan** teaching the outer shell (3) comprising a tubular part cylindrical member (3), (Figure 3); wherein the tube has a pair of substantially parallel opposing edges (the end edges near item (6) in Annotated Figure 2, Version #2 Below) on either side of a gap, (Figure 2). **lan as modified by Homolka et al.** does not teach the cylindrical member extending over an angle in the range of 260 to 280 degrees, but **lan** does teach a range (HH) about a longitudinal centre line (GG) of the outer shell (3) which is very similar to the claimed range, (Annotated Figure 2, Version #2 Below). Therefore, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the



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only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). It would have been obvious to one of ordinary skill in the art to modify the prior art device of **Ian as modified by Homolka et al.** to have the cylindrical member extending over an angle in the range of 260 to 280 degrees for the purpose of user design as it would not cause the device to perform differently.



Annotated Figure 2, Version #2 (Ian)

Regarding **Claims 66-68**, **Ian as modified by Homolka et al.** teaches the limitations discussed above, in addition to teaching various dimensional aspects of the claimed invention. **Ian as modified by Homolka et al.** does not teach the exact

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dimensional aspects as recited in claims 66-68. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm or an outer wall thickness between 7-9mm since the column protector of **lan as modified by Homolka et al.** would not perform differently than it would before with its previous dimensions.

Regarding to **Claim 69**, **lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching a pair of opposing edges (6) spaced apart from one another at a given distance, (Figure 2). **lan as modified by Homolka et al.** does not teach that given distance being between 5cm and 11cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it

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would have been obvious to one of ordinary skill in the art at the time of the invention to provide the distance between the opposing edges of **lan as modified by Homolka et al.** to be between 5cm and 11cm as this would not affect the functioning of the device of **lan as modified by Homolka et al.**

Regarding **Claim 71, lan as modified by Homolka et al.** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to **lan** teaching the outer shell being made from polycarbonate, (Page 2, Line 8). It should also be understood that the following materials are all well known in the art as substitutions for polycarbonate: resilient elastomeric polymer based materials; polyethylene; high density polyethylene; polypropylene; polyvinylchloride; polystyrene; plastic; or a mixture of plastics.

Regarding **Claim 74, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the outer surface of the substantially U shaped channel of the inner liner (the inner surface of (1)) being separated a given distance from outer part cylindrical surface (outer surface of liner (2)), (Figure 2). **lan as modified by Homolka** does not teach the given dimensions being in the range of 2 to 5cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it

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would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of **lan as modified by Homolka et al.** with a distance between the outer part cylindrical surface and the outer surface of the U-shaped channel between 2-5cm since the column protector of **lan as modified by Homolka et al.** would operate equally the same with any desired dimensions.

Regarding **Claim 75, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner being made from a compressive composite material, (Figure 2 and Page 2, Lines 1-7). Wherein, it should be understood that the Examiner takes OFFICIAL NOTICE that the following materials are all well known in the art as substitutions for a compressive composite material: polyethylene; polypropylene; polycarbonate; polyvinylchloride; polystyrene; natural rubber foam; synthetic rubber foam; closed cell SBR foam material.

Regarding **Claims 76 and 77, lan as modified by Homolka et al.** teaches the limitations discussed above, in addition to **lan** teaching various dimensional aspects of the claimed invention. **lan as modified by Homolka et al.** does not teach the exact dimensional aspects as recited in claims 76 and 77. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary

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skill in the art at the time of the invention to provide the inner liner of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

Regarding **Claims 78 and 79, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner (1 and 2) being U-shaped and having a given width and depth dimension, (Figures 1(a) and 1(b)). **lan as modified by Homolka et al.** does not teach the exact dimensional aspects of the width and depth dimensions as recited in claims 78 and 79. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide "U" shaped channel of the inner liner of **lan as modified by Homolka et al.** with width in the range of 7 to 12 cm, or a depth in the range of 2 to 4cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

8. **Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (lan) in view of U.S. Patent No. 6,684,572 (Homolka et al.), and further in view of U.S. Patent No. 4,088,229 (Jacoby et al.).**

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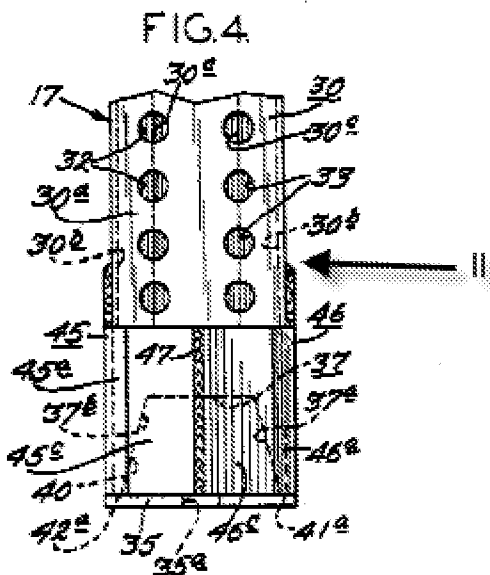
Regarding **Claim 70, Ian as modified by Homolka et al.** teaches the limitations discussed above, but does not teach the outer shell having a chamfered edge.

However, **Jacoby et al.** teaches a shell of a protector having a chamfered edge (II) between its outer and inner surface, (Annotated Figure 4 Below). Therefore, it would

have been obvious to one of ordinary skill in the art to modify **lan as modified by**

**Homolka et al.** to have the outer shell with chamfered edges as taught by **Jacoby et al.**

for the purpose of user efficiency and improved protection of the upright column.



### Annotated Figure 4

### ***Response to Arguments***

9. Applicant's arguments filed 11/05/10 have been fully considered but they are not persuasive.

10. The applicant argues:

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*“lan does not have a “rigid substantially cylindrical outer shell of a substantially “C” shaped cross section.””*

However, U.S. Patent No. 6,684,572 (Homolka et al.) has been added to the rejection as is stated above, wherein Homolka et al. clearly shows that an outer shell may have a cylindrical, “C” shaped cross section. Furthermore, applicant is advised that it is extremely well known in the art to make bumpers and Column guards cylindrical in cross section as is evidenced by: U.S. Patents No. 1,620,933 (Wilcox), No. 3,372,552 (Liddel), No. 4,113,110 (Mittag), No. 5,482,238 (Kreiter), No. 6,102,611 (Roller) and No. 6,242,070 (Gillispie et al.).

### **Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josh Rodden whose telephone number is (571) 270-5222. The examiner can normally be reached on M-Th 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darnell Jayne can be reached on (571) 272-7723. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Michael Safavi/  
Primary Examiner, Art Unit 3637

/Joshua Rodden/  
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